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U.S. Application No. 10/026,704 Art Unit 2661
Response to January 25, 2007 Office Action

REMARKS

In response to the Office Action dated January 25, 2007, the Assignee respectfully requests reconsideration based only on the following remarks. The Assignee respectfully submits that the pending claims already distinguish over the cited documents.

Claims 19-31 are pending in this application. Claims 1-18 have been previously canceled without prejudice or disclaimer.

Claims 19-31 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent Application Publication 2005/0262542 to DeWeese *et al.* in view of U.S. Patent 5,548,346 to Mimura *et al.* and further in view of U.S. Patent 5,671,267 to August, *et al.*

The Assignee shows, however, that claims 19-31 cannot be obvious over the cited documents. First, the proposed combination of *DeWeese*, *Mimura*, and *August* fails to teach or suggest all the claimed features. Second, *DeWeese* "teaches away" and cannot support the Examiner's *prima facie* cases. The Assignee thus respectfully requests removal of the § 103 (a) rejection of claims 19-31.

Inconsistency in Office Action

The January 25, 2007 office action is difficult to understand. The Office Action states that claims 19-31 were rejected in view of the combination of *DeWeese* and *Mimura*. The Office Action then goes on, however, to discuss *August* with regard to all of the claims. The Assignee has thus assumed that claims 19-31 were rejected over the combination of *DeWeese*, *Mimura*, and *August*.

***DeWeese, Mimura, & August* Fail to Teach or Suggest All Claimed Features**

Claims 19-31 were rejected under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent Application Publication 2005/0262542 to DeWeese *et al.* in view of U.S. Patent 5,548,346 to

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Mimura *et al.* and further in view of U.S. Patent 5,671,267 to August, *et al.* If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P.").

Claims 19-31 cannot be obvious. These claims recite, or incorporate, features that are not taught or suggested by the combined teaching of *DeWeese*, *Mimura*, and *August*. All the independent claims, for example, recite a set top box comprising "*a second output adapted to be received by a second set top box*" and "*a second input adapted to receive audible message information.*" The set top box also comprises "*a back channel communications path that is different from the first input.*"

DeWeese, *Mimura*, and *August* are all silent to these features. No where, for example, does the combined teaching of *DeWeese*, *Mimura*, and *August* disclose a set top box comprising "*a second output adapted to be received by a second set top box.*" Examiner Van Handel cites paragraph [0057] of *DeWeese*, but the Assignee cannot agree. Paragraph [0057] explains how "real time communications and chat requests" may be distributed from a television distribution facility to user equipment. Paragraph [0057] makes absolutely no disclosure of "*a second output adapted to be received by a second set top box.*" *DeWeese* explains that each set top box communicates with a television facility via a communications path (*e.g.*, a coaxial cable). U.S. Patent Application Publication 2005/0262542 to *DeWeese et al.* (Nov. 24, 2005) at paragraphs [0014], [0055], [0056], and [0059]. Each set top box may also be connected to a VCR or other storage device. *See id.* at paragraph [0064]. Each set top box may also be connected to a television. *See id.* at paragraph [0065]. No where, however, does *DeWeese* disclose "*a second output adapted to be received by a second set top box.*" *DeWeese*, quite simply, is entirely silent to "*a second output adapted to be received by a second set top box.*" As *DeWeese*, *Mimura*, and *August* are all silent to these features, claims 19-31 cannot be obvious.

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Moreover, claims 19-31 include additional distinguishing features. *DeWeese, Mimura, and August* are all silent to “a second input adapted to receive audible message information.” Examiner Van Handel cites paragraphs [0101] and [0105] of *DeWeese*, but the Assignee cannot agree. Paragraph [0101] explains how real time audio communications may be exchanged during a television program. Paragraph [0105] explains how these real time audio communications may be spoken into a microphone and sent to chat participants. Paragraphs [0101] and [0105], however, are entirely silent to “a second input adapted to receive audible message information.” As *DeWeese* explains, these real time audio communications are transmitted “via communications paths 224.” U.S. Patent Application Publication 2005/0262542 to *DeWeese et al.* (Nov. 24, 2005) at paragraph [0102]. This communications path, however, is the same coaxial cable that also carries the television signals. As *DeWeese* explains, this communications path is a coaxial cable “that eliminates[s] the need for additional communications paths separate from the paths that carry television signal broadcast channels for the transmission of chat communications.” *Id.* at paragraph [0014]. Because *DeWeese* communicates television signals and chat communications over the same coaxial cable, *DeWeese* entirely silent to “a second input adapted to receive audible message information.”

Claims 19-31, then, cannot be obvious. *DeWeese, Mimura, and August* fail to teach or suggest many of the claimed features. Because *DeWeese, Mimura, and August* are silent to many of the claimed features, one of ordinary skill in the art would not think that claims 19-31 are obvious. The Assignee thus respectfully requests removal of the § 103 (a) rejection of claims 19-31.

DeWeese “Teaches “Away”

DeWeese “teaches away” and cannot support the Examiner’s *prima facie* cases. “A reference that ‘teaches away’ from the claimed invention is a significant factor” when determining obviousness. See M.P.E.P. at § 2145 (X)(D)(1). A reference must be considered as a whole, including portions that lead away from the claimed invention. See *id.* at § 2141.02; see

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also *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "It is improper to combine references where the references teach away from their combination." M.P.E.P. at § 2145 (X)(D)(2). **If the proposed combination changes the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to support a *prima facie* case.** See M.P.E.P. at § 2143.01 (emphasis added).

Any combination involving *DeWeese* requires an impermissible change to *DeWeese*'s principle of operation. The Office attempts to combine *DeWeese*'s "television chat system" with *Mimura*'s "TV conferencing system" and with *August*'s telephone handset. *DeWeese*'s principle of operation, however, must be impermissibly changed to support the Examiner's *prima facie* cases. As the following paragraphs explain, *DeWeese*'s principle of operation is to cancel a program's audio from sent chat messages. That is, when chat messages are recorded by a microphone, the TV program's audio is subtracted from inputs to the microphone. The only way for *DeWeese*, *Mimura*, and *August* to reduce "*a volume of the audio signal ... below a volume of the received audible message information being played*," as independent claims 19 and 30 recite, is to change, or even eliminate, principle operating aspects of *DeWeese*'s "television chat system." *DeWeese*, therefore, "teaches away" and cannot support the Examiner's *prima facie* cases.

DeWeese explains its principle of operation. *DeWeese* discloses how a current TV program's audio may be canceled from chat messages. See U.S. Patent Application Publication 2005/0262542 to *DeWeese et al.* (Nov. 24, 2005) at paragraph [0102]. As *DeWeese* explains, though, *DeWeese* cancels a program's audio from sent chat messages. When chat messages are recorded by a microphone, the TV program's audio is subtracted from inputs to the microphone. See *id.* at paragraph [0102]. *DeWeese* explains that "audio from the current TV program" is canceled from the user's sent audio chat messages "so that the recipient user does not hear the TV program audio along with the sender's audio messages." *Id.* at paragraph [0102] (emphasis added).

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DeWeese must, therefore, “teach away” from the pending claims. *DeWeese* cancels a program’s audio from sent chat messages. Independent claims 19 and 30, however, recite “a volume of the audio signal is reduced below a volume of the received audible message information being played.” Because the application to *DeWeese*, *et al.* cancels a TV program’s audio from sent chat messages, *DeWeese*’s principle of operation must be changed. The patent laws, however, forbid changing a principle of operation to support a *prima facie* case of obviousness. Because such changes are not permissible, *DeWeese* “teaches away” and cannot support the Examiner’s *prima facie* cases. The Assignee thus respectfully requests removal of the § 103 (a) rejection of claims 19-31.

Prima Facie Case is Defective

The Examiner’s *prima facie* case for obviousness is defective. A *prima facie* case for obviousness must include “a reasonable expectation of success.” DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition). Here, however, the Examiner has wholly failed to include any expectation of success. The Office, then, has failed to carry the burden, so the *prima facie* case for obviousness must fail. The Assignee thus respectfully asserts that the § 103 (a) rejection of the claims should be removed.

No Reasonable Expectation of Success is Possible

The proposed combination of *DeWeese*, *Mimura*, and *August* cannot support a reasonable expectation of success. As the above paragraph explained, there must be a reasonable expectation of success when combining documents. See M.P.E.P. § 2143. Here, however, the Examiner’s *prima facie* case cannot have a reasonable expectation of success. Because *DeWeese* cancels audio by comparing and subtracting a TV program’s audio from a microphone’s input signal, one of ordinary skill in the art would not expect success when attempting to combine the teachings of *DeWeese* with the teachings of *Mimura* and/or *August*. The application to *DeWeese* cannot be used to reduce “a volume of the audio signal ... below a volume of the received audible message information being played,” as independent claims 19 and 30 recite, without changing, or

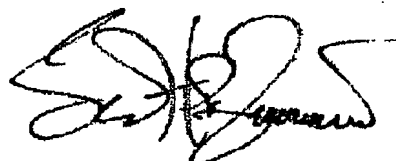
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even eliminating, its principle of operation. One of ordinary skill in the art, then, would not expect success when attempting to combine *DeWeese* with *Mimura* and/or *August*. The § 103 (a) rejection of the pending claims, therefore, should be removed.

If any questions arise, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Scott P. Zimmerman', with a stylized flourish at the end.

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